

## **REMARKS**

This paper responds to the Office Action dated July 1, 2005.

Claims 13, 22, and 26 are amended. Claims 1-38 remain pending in this application.

Independent claim 13 is amended only for clarity.

### **§102 Rejection of the Claims**

**Claims 13, 17, 18, 21 and 34 were rejected under 35 U.S.C. § 102(b) for anticipation by Mizoguchi et al. (U.S. 5,387,551).**

Applicant respectfully traverses.

Independent claim 13 recites, among other things, "depositing" a second magnetic layer on the second non-magnetic insulating layer. Mizoguchi et al. teaches a magnetic film (see for examples, element 114 in FIG. 4, element 23 in FIG. 7B, element 42 in FIG. 11C, or element 62 in FIG. 13C). In Mizoguchi et al., a first group of elements including an insulating layer is formed on a first substrate; the magnetic film is independently formed on a second substrate. The magnetic film on the second substrate is subsequently flipped over and "adhered" to the first group of elements on the first substrate (see for examples, column 5, lines 30-32, column 6, lines 24-26, column 7, lines 39-42, column 8, lines 5-8, and column 8, lines 25-29). Applicant is unable to find in Mizoguchi et al. that the magnetic film of Mizoguchi et al. is deposited over a second non-magnetic insulating layer by a "depositing" process, as claimed in claim 13. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claim 13 and dependent claim 17.

Independent claim 18 recites, among other things, "depositing" a second magnetic layer on the second non-magnetic insulating layer. As presented above regarding claim 13, Applicant is unable to find in Mizoguchi et al. that the magnetic film of Mizoguchi et al. is deposited over a second non-magnetic insulating layer by a "depositing" process, as claimed in claim 18. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claim 18 and dependent claim 21.

Independent claim 34 recites, among other things, "depositing" a second magnetic material layer on the second non-magnetic insulating layer. As presented above regarding claim 13, Applicant is unable to find in Mizoguchi et al. that the magnetic film of Mizoguchi et al. is

deposited over a second non-magnetic insulating layer by a "depositing" process, as claimed in claim 34. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claim 34.

**§103 Rejection of the Claims**

**Claims 22-30 and 35-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitamura et al. (U.S. 6,448,879) in view of Walsh (U.S. 6,233,834).**

Applicant respectfully traverses.

Independent claim 22 is amended and recites, among other things, "forming a circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, the open inductor pattern having an outer edge, wherein the open inductor pattern is unconnected to the layer of magnetic material". Applicant is unable to find in Kitamura et al. and Walsh, either individually or in combination, "forming a circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, the open inductor pattern having an outer edge, wherein the open inductor pattern is unconnected to the layer of magnetic material". Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claim 22.

Independent claim 23 recites, among other things, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Applicant is unable to find in Kitamura et al. and Walsh, either individually or in combination, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claim 23.

Dependent claims 24 and 25 depend from claim 23 and recite the things of claim 23. Thus, Applicant believes that claims 24 and 25 are patentable over Kitamura et al. and Walsh, either individually or in combination, for at least the reasons presented above regarding claim 23 and for the additional things recited in claims 24 and 25. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 24 and 25.

Independent claim 26 is amended and recites, among other things, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Applicant is unable to find in Kitamura et al. and Walsh, either individually or in combination, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claim 26.

Independent claim 27 is amended and recites, among other things, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Applicant is unable to find in Kitamura and Walsh, either individually or in combination, "forming a substantially circular open inductor pattern in the non-magnetic insulating layer and above the magnetic material layer, wherein the open inductor pattern is unconnected to the layer of magnetic material". Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claim 27.

Dependent claims 28-30 depend from claim 27 and recite the things of claim 27. Thus, Applicant believes that claims 28-30 are patentable over Kitamura et al. and Walsh, either individually or in combination, for at least the reasons presented above regarding claim 27 and for the additional things recited in claims 28-30. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 28-30.

Dependent claims 35 and 36 depend from claim 22 and recite the things of claim 22. Thus, Applicant believes that claims 35 and 36 are patentable over Kitamura et al. and Walsh, either individually or in combination, for at least the reasons presented above regarding claim 22 and for the additional things recited in claims 35 and 36. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 35 and 36.

Dependent claims 37 and 38 depend from claim 26 and recite the things of claim 26. Thus, Applicant believes that claims 37 and 38 are patentable over Kitamura et al. and Walsh, either individually or in combination, for at least the reasons presented above regarding claim 26

and for the additional things recited in claims 37 and 38. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 37 and 38.

**Claims 14-16, 19, 20, 23-25 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizoguchi et al. (U.S. 5,387,551).**

Applicant respectfully traverses.

The Office Action cites a single document to reject claims 14-16, 19, 20, 23-25 and 27-30 of the present application under 35 USC § 103(a) based on reasons that some of the specific features in these claims, although not specified in the single document, are obvious matters of design choice. Applicant assumes that the Examiner is taking Official Notice in rejecting these claims because the Office Action offers no documents to support the rejection of the specific features in these claims. Applicant respectfully traverses the taking of Official Notice and, pursuant to M.P.E.P. § 2144.03, Applicant requests documents or an affidavit to support the rejection. Moreover, Applicant cannot find in Mizoguchi et al. a motivation to modify the teaching of Mizoguchi et al. as proposed in the Office Action. In the absence of documents or an affidavit to support the rejection of claims 14-16, 19, 20, 23-25 and 27-30, Applicant requests that the rejection be reconsidered and withdrawn, and that claims 14-16, 19, 20, 23-25 and 27-30 be allowed.

Notwithstanding the objection to the taking of Official Notice above, Applicant believes that claims 14-16, 19, 20, 23-25 and 27-30 are patentable over Mizoguchi et al. for the reasons presented below.

Dependent claims 14-16 depend from claim 13 and recite the things of claim 13. Thus, Applicant believes that claims 14-16 are patentable over Mizoguchi et al. for at least the reasons presented above regarding claim 13 and for the additional things recited in claims 14-16. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 14-16.

Dependent claims 19 and 20 depend from claim 18 and recite the things of claim 18. Thus, Applicant believes that claims 19 and 20 are patentable over Mizoguchi et al. for at least the reasons presented above regarding claim 18 and for the additional things recited in claims 19 and 20. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 19 and 20.

Independent claim 23 recites, among other things, "depositing" a second magnetic layer on the second non-magnetic insulating layer. As presented above regarding claim 13, Applicant is unable to find in Mizoguchi et al. that the magnetic film of Mizoguchi et al. is deposited over a second non-magnetic insulating layer by a "depositing" process, as claimed in claim 23. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claim 23.

Dependent claims 24 and 25 depend from claim 23 and recite the things of claim 23. Thus, Applicant believes that claims 24 and 25 are patentable over Mizoguchi et al. for at least the reasons presented above regarding claim 23 and for the additional things recited in claims 24 and 25. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 24 and 25.

Independent claim 27 recites, among other things, "depositing" a second magnetic layer on the second non-magnetic insulating layer. As presented above regarding claim 13, Applicant is unable to find in Mizoguchi et al. that the magnetic film of Mizoguchi et al. is deposited over a second non-magnetic insulating layer by a "depositing" process, as claimed in claim 27. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claim 27.

Dependent claims 28-30 depend from claim 27 and recite the things of claim 27. Thus, Applicant believes that claims 28-30 are patentable over Mizoguchi et al. for at least the reasons presented above regarding claim 27 and for the additional things recited in claims 28-30. Accordingly, Applicant requests reconsideration and withdrawal of the rejection, and allowance of claims 28-30.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6969 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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